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EXAMINER

PEACHES, RANDY

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/814,363

Applicant(s)

UNG ET AL.

Examiner

Randy Peaches

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-62 is/are rejected.
- 7) ☒ Claim(s) 61 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/22/04 has been entered.

### ***Claim Objections***

***Claim 61*** is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Examiner respectfully suggests that the dependency of ***claim 61*** should be changed to ***claim 53***.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. ***Claims 1-16, 20-25, 29-47, 51-56 and 60-62*** are rejected under 35 U.S.C. 102(e) as being unpatentable by Mcdowell et al (U.S. Publication 2001/0034224 A1).

Regarding ***claims 1, 7, 32 and 38***, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in paragraph [0039], a short message service (SMS) server, which reads on claimed "short message service center (SMSC)", a home location register (HLR), which reads on claimed "module", for permitting automatic status tracking of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", by an application external to a cellular/PCS network (see FIGURE 1 paragraph [0035]), which reads on claimed "service provider", including said SMSC, a message handler comprising:

- a registration notification message (REGNOT) and MSINACT, which reads on claimed "MSInactivity", receiver to alert other wireless users of a said user's presence (see paragraph [0032]). Mcdowell discloses in paragraph [0046], that

REGNOT/MSINACT receiver is a Message Event Server (MES) capable of receiving and processing the user event information (e.g. network information relating to the presence and/or location of a said wireless user (see paragraph [0044, 0045]) received over a TCP/IP connection from a said HLR and further producing an associated presence and/or location; and

- a registration notification message (REGNOT) and MSINACT, which reads on claimed "MSInactivity", forwarder to forward a said (REGNOT) and MSINACT received by a Message Event Server, over an internet connection to a device outside a wireless network. **NOTE:** (McDowell et al. teaches in paragraph [0040] and [0041] wherein the said SMS server sends an over the air message or similar type informing the said user of the presence of a subscriber. The instant function satisfies the limitation of "integrated in the SMSC", in that, the said SMS server forwards information to a user; therefore, a "forwarding mechanism" is a part of the architecture of the said SMS server). Also, as detailed in FIGURE 10a, the cellular network comprises the mobile switch center, which sends the said registration notification message (REGNOT) and MSINACT to the said MES.

McDowell et al. discloses in paragraph [0046] wherein the forwarded information details whether or not the information is sent to a user within the said wireless network or outside the said wireless network, which reads on claimed "device outside of a wireless network." . See paragraph [0033, 0046].

Regarding **claims 2, 8, 33 and 39**, according to **claims 1, 7, 32 and 38**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in paragraph [0039], a short message service (SMS) server, which reads on claimed "short message service center (SMSC)", a home location register (HLR), which reads on claimed "module", for permitting automatic status tracking of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", by an application external to a cellular/PCS network (see FIGURE 1 paragraph [0035]), which reads on claimed "service provider", including said SMSC, a message handler wherein:

- Mcdowell et al teaches in paragraph [0035], that the said Internet connection utilizes a TCP/IP protocol.

Regarding **claims 3, 9, 34 and 40**, according to **claims 1, 7, 32 and 38**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in paragraph [0039], a short message service (SMS) server, which reads on claimed "short message service center (SMSC)", a home location register (HLR), which reads on claimed "module", for permitting automatic status tracking of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", by an application external to a cellular/PCS network (see FIGURE 1 paragraph [0035]), which reads on claimed "service provider", including said SMSC, a message handler wherein:

- said registration notification message (REGNOT) and MSINACT (user event information) forwarder replicates, which reads on claimed "copies", all said

REGNOT and MSINACT received by said MSC. See paragraphs [0044, 0045, 0046].

Regarding **claims 4, 10, 35 and 41**, according to **claims 1, 7, 32 and 38**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in paragraph [0039], a short message service (SMS) server, which reads on claimed "short message service center (SMSC)", a home location register (HLR), which reads on claimed "module", for permitting automatic status tracking of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", by an application external to a cellular/PCS network (see FIGURE 1 paragraph [0035]), which reads on claimed "service provider", including said SMSC, a message handler wherein:

- a gateway, which reads on claimed "wireless internet gateway", to transmit said forwarded notification messages (user event information) over said Internet connection. See FIGURE 1 paragraphs [0033, 0035, 0037, 0039, 0041].

Regarding **claims 5, 11, 36 and 42**, according to **claims 4, 10, 35 and 41**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in paragraph [0039], a short message service (SMS) server, which reads on claimed "short message service center (SMSC)", a home location register (HLR), which reads on claimed "module", for permitting automatic status tracking of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", by an

application external to a cellular/PCS network (see FIGURE 1 paragraph [0035]), which reads on claimed "service provider", including said SMSC, a message handler wherein:

- said registration notification message (REGNOT) and MSINACT (user event information) handler communicates with the said gateway, which reads on claimed "wireless internet gateway", using signaling system #7 (SS7) communication protocol. See paragraphs [0033, 0037, 0039, 0041, 0047].

Regarding **claims 6, 12, 37 and 43**, according to **claims 1, 7, 32 and 38**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in paragraph [0039], a short message service (SMS) server, which reads on claimed "short message service center (SMSC)", a home location register (HLR), which reads on claimed "module", for permitting automatic status tracking of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", by an application external to a cellular/PCS network (see FIGURE 1 paragraph [0035]), which reads on claimed "service provider", including said SMSC, a message handler wherein:

- said registration notification message (REGNOT) and MSINACT (user event information) is previously forwarded by a said HLR. See FIGURE 10a paragraphs [0029, 0032, 0039].

Regarding **claims 13, 22, 44 and 53**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in FIGURE 10a and 10b paragraphs [0039, 0046, 0057, 0058], of a method and system, which reads on claimed "apparatus", for automatically notifying an external message distribution system, commonly referred to as a Short Message



Service Center (SMSC), which reads on claimed “external chat server”, of the presence of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed “chat session participant”, comprising:

- receiving an IS-41 conforming registration notification message (REGNOT), as taught by McDowell et al when an event trigger is initiated in paragraphs [0046, 0056, 0057, 0058], e.g. when a said user’s device is turned on, from a Mobile Switching Center (MSC); and
- automatically forwarding, see FIGURE 10a paragraphs [0032], the said IS-41 conforming registration notification message (REGNOT) over an internet connection, see paragraph [0033], to a said Short Message Service Center (SMSC), which reads on claimed “external chat server”. McDowell et al teaches of this occurrence in paragraph [0046].
- Additionally, McDowell et al. continues to teach in paragraph [0046], that the transmission of information may be conducted over a variety of communication links, such as TCP/IP.

Regarding **claims 14, 23, 45 and 54**, according to **claims 13, 22, 44 and 53**, McDowell et al (U.S. Publication 2001/0034224 A1) discloses in FIGURE 10a and 10b paragraphs [0039, 0046, 0057, 0058], of a method and system, which reads on claimed “apparatus”, for automatically notifying an external message distribution system, commonly referred to as a Short Message Service Center (SMSC), which reads on claimed “external chat server”, of the presence of a wireless user e.g. wireless

telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", wherein:

- said registration notification message is a REGNOT message. See paragraph [0046]. Examiner further concludes, as evident in FIGURE 10a, the HLR is receiving the said notification message from the said MSC over a said Internet connection.

Regarding **claims 15, 24, 46 and 55**, according to **claims 13, 22, 44 and 53**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in FIGURE 10a and 10b paragraphs [0039, 0046, 0057, 0058], of a method and system, which reads on claimed "apparatus", for automatically notifying an external message distribution system, commonly referred to as a Short Message Service Center (SMSC), which reads on claimed "external chat server", of the presence of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", wherein:

- Mcdowell et al teaches in paragraph [0035], that the said Internet connection utilizes a TCP/IP protocol.

Regarding **claims 16, 25, 47 and 56**, according to **claims 13, 22, 44 and 53**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in FIGURE 10a and 10b paragraphs [0039, 0046, 0057, 0058], of a method and system, which reads on claimed "apparatus", for automatically notifying an external message distribution system,

commonly referred to as a Short Message Service Center (SMSC), which reads on claimed "external chat server", of the presence of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", wherein:

- Mcdowell et al teaches in paragraphs [0035, 0039, 0040], said registration notification message is additionally forwarded by a said SMSC.

Regarding **claims 20, 29, 51 and 60**, according to **claims 13, 22, 44 and 53**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in FIGURE 10a and 10b paragraphs [0039, 0046, 0057, 0058], of a method and system, which reads on claimed "apparatus", for automatically notifying an external message distribution system, commonly referred to as a Short Message Service Center (SMSC), which reads on claimed "external chat server", of the presence of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", wherein:

- said registration notification message is signaling system #7 (SS7) and IS-41 compliant. See paragraph [0046, 0054].

Regarding **claims 21, 30, 52 and 61**, according to **claims 13, 22, and 44**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in FIGURE 10a and 10b paragraphs [0039, 0046, 0057, 0058], of a method and system, which reads on claimed "apparatus", for automatically notifying an external message distribution system,

commonly referred to as a Short Message Service Center (SMSC), which reads on claimed "external chat server", of the presence of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", wherein:

- said registration notification message is IS-41 compliant. See paragraph [0046, 0054].

Regarding **claims 31 and 62**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in FIGURE 10a and 10b paragraphs [0039, 0046, 0057, 0058], of a method for automatically notifying an external message distribution system, commonly referred to as a Mobile Event Server (MES), which reads on claimed "external chat server", of the presence of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", comprising:

- receiving an IS-41 conforming MSINACT, which reads on claimed "MSInactivity notification", as taught by Mcdowell et al when an event trigger is initiated in paragraphs [0046, 0056, 0057, 0058], e.g. when a said user's device is turned on, from a Mobile Switching Center (MSC); and
- automatically forwarding, see FIGURE 10a paragraphs [0032], the said IS-41 conforming MSINACT, which reads on claimed "MSInactivity notification", over an internet connection, see paragraph [0033], to a said Mobile Event Server (MES), which reads on claimed "external chat server". Mcdowell et al teaches of this occurrence in paragraph [0046].

- Additionally, McDowell et al. continues to teach in paragraph [0046], that the transmission of information may be conducted over a variety of communication links, such as TCP/IP.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. ***Claims 17-19, 26-28, 48-50 and 57-59*** are rejected under 35 U.S.C. 103(a) as being unpatentable over McDowell et al (U.S. Publication 2001/0034224 A1) in view of Sandegren (U.S. Patent 6,512,930 B2).

Regarding ***claims 17, 26, 48 and 57***, according to ***claims 13, 22, 44 and 53***, McDowell et al fails to disclose of adding a user corresponding to the forwarded registration notification message to a chat session.

Sandegren (U.S. Patent 6,512,930 B2) teaches in column 5 and 6 lines 46-67 lines 1-17 respectively, of automatically adding a user of a mobile station corresponding to a said forwarded notification that the said user is "on-line", which in turn, adds the user to a list of individuals whose status of communication is of relevance to the said user (see column 3 lines 1-10), which reads on claim "chat session".

Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to modify McDowell et al (U.S. Publication 2001/0034224 A1) to include Sandegren (U.S. Patent 6,512,930 B2) in order to achieve a method and apparatus where a user corresponding to a forwarded notification message can be automatically added to a chat session.

Regarding **claims 18, 27, 49 and 58**, according to **claims 17, 26, 48 and 57**, McDowell fails to disclose of automatically notifying other chat participants of the presence of the added user.

Sandegren (U.S. Patent 6,512,930 B2) teaches in column 5 and 6 lines 46-67 lines 1-17 respectively, of automatically adding a user of a mobile station corresponding to a said forwarded notification that the said user is "on-line", which in turn, adds the user to a list of individuals whose status of communication is of relevance to the said user (see column 3 lines 1-10), which reads on claim "chat session". Additionally, as stated in column 3 lines 56-66, that an action is performed in order to notify other chat participants, which reads on claimed "chat participants", who are of the same status as the added user that the user is available for communication.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the teachings of McDowell et al (U.S. Publication 2001/0034224 A1) in view of Sandegren (U.S. Patent 6,512,930 B2) in order to achieve a method and apparatus which automatically notifies other chat participants regarding the presence of an automatically added said user.

Regarding **claims 19, 28, 50 and 59**, according to **claims 17, 26, 48 and 57**, McDowell fails to disclose of an external server automatically sending a list of chat participants to the added user.

Sandegren (U.S. Patent 6,512,930 B2) teaches in column 5 and 6 lines 46-67 lines 1-17 respectively, that the server or Wireless On-line Notification (WOLN) server sends a list of "on-line" users, which reads on claimed "chat participants", to a said user of interest.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the teachings of McDowell et al (U.S. Publication 2001/0034224 A1) in view of Sandegren (U.S. Patent 6,512,930 B2) in order to achieve a method and apparatus which automatically sends a list of chat participant to a user of interest to established communications with the list chat participants if the user so desires.

***Response to Arguments***

Applicant's arguments with respect to ***claims 1-62*** have been considered but are moot in view of the new ground(s) of rejection.

Regarding the usage to the McDowell's Provisional Application as prior art under 35 USC 102(e). A provisional application constitutes as an application for a patent and therefore, the rejection of ***claims 1-12 and 32-43***, under 35 U.S.C. 102(e) stands as applied.

Regarding the Applicant's comments in respect to McDowell et al. and Sandegren teachings of forwarding a registration notification message and an MSInactivity message from a short message service center to a device outside of a wireless network.

Per the above rejection, McDowell et al. teaches in paragraph [0040] and [0041] wherein the said SMS server sends an over the air message or similar type informing the said user of the presence of a subscriber. The instant function satisfies the limitation of integrated in the SMSC, in that, the said SMS server forwards information to a user; therefore, a "forwarding mechanism" is a part of the architecture of the said SMS server.

Therefore, based on the above rejection and the additional presented information, the Examiner concludes that ***claims 1-62*** stand rejected based on the new grounds of rejection.



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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy Peaches whose telephone number is (571) 272-7914. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Randy Peaches  
May 2, 2005

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